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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 580,515	05 25 2000	Jay M. Short	DIVER1370-4	9360

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EXAMINER

RAMIREZ, DELIA M

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 03 27 2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/580,515

Applicant(s)

SHORT ET AL

Examiner

Delia M. Ramirez

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 10 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) 1-17 and 19-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 18 and 41-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 25 May 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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## **DETAILED ACTION**

### ***Status of the Application***

Claims 1-48 are pending.

Applicant's election with traverse of Group IV, claim 18 drawn to a method to produce animal feed containing the microbial phytase of SEQ ID NO: 2, in Paper No. 7, filed on 1/10/2002 and an Information Disclosure Statement in Paper No. 4, filed on 12/27/2000 are acknowledged.

Applicant's traverse is on the ground(s) that (1) the claims have been inappropriately divided into 10 Groups, (2) Groups I-V can be searched together since they are related as molecules, methods of use, and methods of production, (3) in the alternative, Groups I, II, and IV should be rejoined because the search is co-extensive and the classification is the same for Groups I and IV.

Applicant's argument have been fully considered but are not found persuasive. Applicants have not indicated why Groups VI-X should be rejoined or why the claims in Groups VI-X were inappropriately divided. In regard to the search of Groups I-V, while it is true that publications containing polynucleotide (Group II) information such as open reading frame sequences typically disclose the corresponding polypeptide, it is false to assume that the only source of information about a polypeptide, methods of use, or methods of production of the protein, is one in which polynucleotide information is disclosed. In regard to the rejoinder of Groups I, II, and IV, not only is the search for those groups not co-extensive as explained previously, but the search must include non-patent literature in order to be comprehensive. Therefore, the Examiner must search not only in the patent literature (class/subclass), but also for

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polynucleotide information, information on the polypeptide, methods of use, and methods for production of the protein.

The requirement is deemed proper and therefore is made FINAL.

Claims 1-17 and 19-40 are withdrawn from further consideration by the Examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### *Specification*

1. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01. See for example, pages 25-26 and 28 of the specification.

2. Applicant is reminded of the following requirement: the first paragraph of the specification should contain or be amended to contain a reference to prior U.S. patents, copending provisional and non-provisional applications. See 37 CFR 1.78(a)(2). Applicant has not updated the status of non-provisional applications 09/318,528, 09/291,931, and 09/259,214, to which priority is being claimed to, in the first paragraph of the specification. Appropriate correction is required.

### *Oath/Declaration*

3. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP § 602.01 and 602.02.

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The oath or declaration is defective because there is no date next to the signature of Inventor Jay Short

***Drawings***

4. The drawings have been reviewed and are approved by a draftsman under 37 CFR 1.84 or 1.152.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 18 (claims 41-48 dependent thereon) is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 18 is indefinite in the recitation of "preparing a plant cell, plant part, or plant that contains a recombinant expression system" as it is unclear what the meaning of the word "preparing" is within the context of the claim. Since the plant cell, plant part, or plant has already been transformed with the DNA encoding the phytase of SEQ ID NO: 2, the term "prepare" cannot be associated with "transform". The word "prepare" can be interpreted as "to subject something to a special treatment or process". Such treatment or process has not been defined in the specification. It is suggested that Applicants clearly define the intended meaning of the term "prepare" in the claim.

***Conclusion***

8. No claim is in condition for allowance.

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9. Applicants are requested to submit a clean copy of the pending claims (including amendments, if any) in future written communications to aid in the examination of this application.

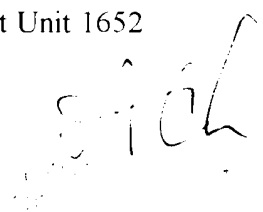
10. Certain papers related to this application may be submitted to Art Unit 1652 by facsimile transmission. The FAX number is (703) 308-4556. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 CFR 1.6(d)). NOTE: If Applicant submits a paper by FAX, the original copy should be retained by Applicant or Applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED, so as to avoid the processing of duplicate papers in the Office.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Delia M. Ramirez whose telephone number is (703) 306-0288. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5 00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Ponnathapura Achutamurthy can be reached on (703) 308-3804. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Delia M. Ramirez, Ph.D.  
Patent Examiner  
Art Unit 1652

DR  
March 18, 2002



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